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REMARKS

I. Claim Objections

Claims 9 and 23 stand objected to because of the following informalities: "actuator" in line 1 of the claims should be changed to —apparatus—. Appropriate correction has been made in claim 9. Claim 23 has been canceled.

II. Claim Rejections

A. Anticipation Rejections

Claims 15, 18-20 and 24-26 stand rejected under 35 U.S.C. 102(b) as being anticipated by Heaton (US 4,452,663). Claim 15 has been amended so as to recite the absence of wall board compound in a more positive manner, and to further characterize the length of the elongated handle (as in claim 23, which is now canceled). Accordingly, the anticipation rejections are respectfully traversed because Heaton fails to teach each and every element of the rejected claims, as is required for a proper anticipation rejection. *MPEP* § 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Heaton describes a device that combines the functions of applying tape and applying compound to wall board. The intended dual function of Heaton compromises the ability of the device to perform either function, when considered independently. For example, although Heaton claims to admit to a number of embodiments, the compound reservoir 28 of Heaton is limited to configurations that establish sufficient hydrostatic pressure for the compound in the reservoir to flow directly to the surface of the tape (see Heaton, col. 3, lines 18-20). This limits that ways in which the apparatus may

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be oriented when applying tape to a wall board seam, because certain orientations will result in a loss or reduction of the hydrostatic pressure required for compound to flow from the reservoir to the dispensed tape. This limitation may be contrasted with the present invention in which the tape dispensing function may be achieved in virtually any orientation of the apparatus without fear of frustrating another intended function, namely the application of compound.

Additionally, the recited "actuator" of claim 15 is qualified as "being separated from the brake by a distance of approximately three feet or more." This feature of the claimed invention is commensurate with one of the advantages of the invention, namely that it be able to apply tape over a wide range of motion, e.g., without requiring the user to rely on mobility aids (*Applicant's Specification*, at page 4, lines 10-12, and page 7, last line through page 8, line 3).

Heaton fails to disclose an elongated handle or the location of an actuator at a position remote from a brake, as is presently claimed. Heaton describes a relatively compact apparatus that purportedly permits a user to apply both tape and compound to a wall board. Heaton also describes a trigger for actuating a brake, with the trigger being positioned near the brake, rather than being remote from the brake in the sense recited by claim 15. There is simply no teaching in Heaton that a braking force be applied to a brake from a remote location, e.g., from a distance of approximately three feet or more. Accordingly, claim 15, as well as the claims that depend therefrom, are also submitted to be patentably distinct over Heaton.

B. Obviousness Rejections

Claims 1, 4-6, 9-12, 15, 23, 29 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton (US 4,452,663) in view of Diaz (US 5,476,571).

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Claims 2, 3, 13, 14 and 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton (US 4,452,663) and Diaz (US 5,476,571) as applied to claim 1 above, and further in view of O'Mara et al. (US 6,540,856).

Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton (US 4,452,663) and Diaz (US 5,476,571) as applied to claim 1 above, and further in view of Shi (US 5,236,540).

Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton (US 4,452,663) and Diaz (US 5,476,571) as applied to claim 1 above, and further in view of Thompson et al. (US 5,792,310).

These rejections are respectfully traversed because the Examiner has failed to present *prima facie* cases of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143. At least one of these criteria is lacking for each of the above-noted obviousness rejections, as explained below.

Section 103(a) of the patent statute (35 U.S.C.) states that "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." In making the assessment of

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differences, Section 103 specifically requires consideration of the claimed invention "as a whole."

Inventions typically are new combinations of existing principles or features. Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction prevents evaluation of the invention on a piecemeal basis. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result -- often the very definition of invention.

Section 103 precludes this hindsight-based discounting of the value of new combinations by requiring assessment of the invention as a whole. The Federal Circuit has provided further assurance of the "as a whole" assessment of the invention under Section 103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, a patent examiner or court must show some suggestion or motivation, prior to the applicant's invention, to support a rejection based upon a new combination of prior art references. In re Rouffet, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998). The requirement of a suggestion to combine is the first of the three above-noted criteria of a *prima facie* case of obviousness.

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More particularly, given the “subtle but powerful attraction of a hindsight-based obviousness analysis,” the law requires a “rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Thus, to properly support a proffered combination of references, a patent examiner “must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them” in the proffered manner. *In re Rouffet*, 149 F.3d at 1359. Close adherence to this rigid methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *Dembiczak*, 175 F.3d at 999 (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)). Additionally, it is never appropriate for an Examiner to rely solely on “common knowledge in the art” without evidentiary support in the record as the principal evidence upon which a rejection was based. *MPEP* § 2144.03.

The obviousness rejections of claims 1 and 29, and claims 2-9, 12-14, and 30-31 that depend therefrom, are predicated on the combination of Heaton with Diaz. Heaton describes a “simple and effective wall board taping apparatus” (col. 1, lines 27-28 of Heaton), while Diaz describes a “three-speed powered sheetrock taping apparatus” (col. 1, lines 38-39 of Diaz). The Examiner admits that Heaton fails to disclose an elongated handle in the sense claimed, but concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the handle of Heaton “to be several feet in length as suggested by Diaz to enable a user to apply tape to an entire standard-height wall joint without utilizing a ladder.” Office Action of May 6, 2005, pages 5, 7-8.

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Heaton discloses a relatively short handle 20 that is used for manipulating a wall board taping apparatus 10. The Heaton apparatus works by passing tape from a roll 44, beneath a brake shoe 48, through a compound reservoir 28, and over (as opposed to under) a roller 22 for application to a wall board surface 50. Because the tape passes over the roller 22, the apparatus 10 of Heaton will necessarily be used to apply tape in an upward stroke from a lower wall board position to an upper wall board position (see, e.g., FIG. 2 of Heaton). The short handle 20 of Heaton complements this upward taping action since it permits the apparatus 10 to be easily manipulated near a lower portion of a wall board that is bounded by a floor (i.e., to begin the taping stroke near the floor for effective tape coverage of the wall board joint or seam). The substitution of the elongated handle of Diaz (called a pole 12) for the shortened handle 20 of Heaton would frustrate a user's ability to position the apparatus 10 of Heaton adjacent a floor because the floor would restrict a user's ability to orient an elongated handle. In other words, the proposed combination of Diaz with Heaton would render the apparatus of Heaton (at least partially) inoperable for its intended purpose. One skilled in the art would be motivated against such a combination, because – at the very least – it would restrict the utility of the Heaton apparatus. As a result, there is no suggestion or motivation to make the proposed modification. MPEP § 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). For this reason, the rejections of claims 1 and 29, as well as those claims dependent thereon are respectfully traversed.

Claim 1 has been amended to incorporate the limitations of claims 10 and 11 therein, and claims 10-11 have been canceled. Claim 12 has been amended to depend from claim 1, rather than from claim 11. Claims 13-14 have been amended to complement the amendment to claim 1. Claim

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29 has been amended to qualify the step of remotely applying a braking force in a similar manner to the amendment of claim 1. A pertinent element of claim 1 as amended (and similarly in claim 29) defines the recited "actuator" as comprising "an elongated link connected to the lever and extending through at least a substantial portion of the elongated handle." The phrase "substantial portion" means over most of the length of the elongated handle, as is illustrated by the elongated link 28 in FIG. 1 of the present application, and as is commonly defined (see, e.g., Merriam-Webster Online, def. 5 for "substantial"). Thus, the proffered combination of Heaton and Diaz, even if properly supported (it is not for reasons expressed above), would fail to teach or suggest this claimed limitation. Thus, the third prong of the *prima facie* case of obviousness (teaching all claim limitations) also fails. For this reason, claims 1 and 29, as well as the claims that depend therefrom, are further submitted to be patentable.

Claims 15-20 and 24-28 also stand rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton (US 4,452,663) in view of O'Mara et al. (US 6,540,856). These rejections are respectfully traversed because the Examiner has failed to present a *prima facie* case of obviousness. O'Mara is actually critical of apparatuses like that of Heaton, which employ a wall board compound ("mud") container that is cumbersome and requires frequent cleaning to avoid contaminating fresh mud with dried mud particles. See O'Mara, at col. 1, lines 20-50. Since O'Mara teaches away from inventions like that of Heaton, one skilled in the art would be motivated against the combination. Thus, it is respectfully submitted that the proffered combination is based upon hindsight reconstruction, rather than upon a suggestion in the art or within the general knowledge of one skilled in the art.

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Furthermore, as mentioned above, the recited "actuator" of claim 15 is qualified as "being separated from the brake by a distance of approximately three feet or more." Neither Heaton nor O'Mara teach this requirement, and for that reason alone these obviousness rejections are not supportable (failure of third prong of *prima facie* case).

Additionally, the recited "frame" of claim 15 is qualified as "being incapable of conveying wall board compound." Heaton is directed to the conveyance of wall board compound in a reservoir; O'Mara is directed to the conveyance of wall board compound via a flexible hose that's connected to a compound reservoir via a pressure source (e.g., a progressive cavity pump). As explained above, the inclusion of such compound-conveyance means restricts the mobility and usefulness of the taping apparatus. The present invention, as defined by claim 15, is not so encumbered because it expressly excludes the conveyance of compound from its frame. This is another instance of the proffered combination failing to teach all the claimed limitations. Accordingly, the *prima facie* case of obviousness based upon Heaton in view of O'Mara fails for this reason as well.

Claims 15, 18-21 and 24-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton (US 4,452,663) in view of Shi (US 5,236,540). Claims 15, 18-20, 22 and 24-26 stand similarly rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton (US 4,452,663) in view of Thompson et al. (US 5,792,310). These rejections are respectfully traversed because the Examiner has failed to present *prima facie* cases of obviousness. Shi is directed to preventing the withdrawal of tape from the applicator roller of a hand-held tape dispenser after the tape has been cut (Shi, col. 1, lines 17-22). Thompson is directed to applying tape dispensed from a hand-held dispenser to boxes. The dissimilar purposes of Shi and Thompson, compared to that of Heaton, negate any implicit

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(much less explicit) suggestion that Shi or Thompson be combined with Heaton.

Furthermore, even if the proffered combinations of references were properly supported, they still fail to teach each of the claimed limitations (the third prong of a *prima facie* case). In particular, the combinations fail to teach the recited "actuator" limitation of claim 15: "being separated from the brake by a distance of approximately three feet or more." Nor do the combinations teach the "frame" limitation of claim 15: "being incapable of conveying wall board compound" (the reservoir of Heaton is not negated by Shi or Thompson). Accordingly, the obviousness rejections of claim 15, and the claims that depend therefrom, are not supportable.

IV. Conclusion

In conclusion, the Applicants submit that all of the pending claims are in condition for allowance. Reconsideration of the claims, withdrawal of the rejections, and passage of the present application to issuance are respectfully requested.

In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/DOBS/0001 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



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